

ESTTA Tracking number: **ESTTA235658**

Filing date: **09/10/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049828
Party	Defendant Minsky, Richard P.
Correspondence Address	Minsky, Richard P. 413 County Route 22 Hudson, NY 12534 UNITED STATES
Submission	Answer
Filer's Name	Tamiko R. Franklin
Filer's e-mail	legal@vipo-online.org, minsky@minsky.com
Signature	/Tamiko R. Franklin/
Date	09/10/2008
Attachments	Answer to petition for cancellation; No.92049828.pdf ( 8 pages )(314542 bytes )



action are responsible for its licensees' adoption of its license, based on acceptance of unconscionable terms contained in its terms of service agreement, and not any valid claim to the generic descriptive term SL.

4. Registrant denies the allegation contained in paragraph 4 of the petition for cancellation that petitioner has valid common law rights in the 'SL' mark and clarifies that the application referenced in paragraph 4 of the petition for cancellation is an intent-to-use application filed with the USPTO on June 05, 2007.

5. Registrant denies the allegations of paragraph 5 of the petition for cancellation and clarifies that SLART® is a mark that is not merely descriptive, but is a multiple "double entendre" that incorporates the generic descriptive term SL and the generic descriptive term ART, creating the distinctive sound "SLART", which has several meanings that include humorous associations.

6. Registrant denies the allegations of paragraph 6 of the petition for cancellation as petitioner does not have established rights in the generic descriptive term SL.

7. Registrant admits the allegations of paragraph 7 of the petition for cancellation.

8. Registrant admits the allegations of paragraph 8 of the petition for cancellation.

9. Registrant admits the allegations of paragraph 9 of the petition for cancellation.

10. Registrant admits the allegations of paragraph 10 of the petition for cancellation so far as the statements presented represent accurate quotations of the

Examining Attorney and denies the allegations of paragraph 10 in as much as they are an incomplete presentation of the statements made by the Examining Attorney and are taken out of context.

11. Registrant admits the allegations of paragraph 11 of the petition for cancellation only so far as the statements presented represent accurate quotations from his response to the office action and denies the allegations of paragraph 11 in as much as they are an incomplete presentation of his statements and are taken out of context.

12. Registrant admits the allegations of paragraph 12 of the petition for cancellation.

13. Registrant admits the allegations of paragraph 13 of the petition for cancellation.

14. Registrant denies the allegations of paragraph 14 of the petition for cancellation. At the time of his filing for registration of his mark SLART on March 22, 2007, Registrant was not aware of Petitioner's June 5, 2007 intent to use application, as it did not exist.

Petitioner did not claim any rights in the term SL prior to filing its intent-to-use application, which contains a sworn affidavit that there was no prior use of the mark. Registrant had no knowledge in December 2006, at the time of commencing use of the term SLART in relation to his commercial activities that Petitioner intended to later claim rights to the generic descriptive term SL.

Petitioner promoted the generic descriptive use of the term SL for the years directly preceding the petitioner's application to register the mark 'SL', being at least two years based on information known to the registrants, and apparently from the date

petitioner first publicly promoted their support of the retention of intellectual property rights by users of petitioner's service, Second Life®, which is at least as early as a press release dated November 14, 2003.

Petitioner did not include 'SL' as a claimed mark on its website until March 24, 2008, six days after the SLART mark was issued its Certificate of Registration. Even if the possibility of having rights had existed previously, after more than four years of widespread use of SL as a generic descriptive term, petitioner had no rights in the mark SL.

15. Registrant denies the allegations of paragraph 15 as the phrase 'members of the general public' does not accurately describe people who knew that there were things known as virtual worlds, that there was a virtual world called Second Life®, that people could make art in that virtual world, and would understand that one of the things that the mark referred to was art in Second Life®.

Registrant admits that at the time of filing there were more members of the general public who would not know that art was being made in this virtual world than those who would, that prior to seeing the term "slart" used in the context of Registrant's services, the large majority of the public would not associate the word "slart" with Second Life, and would more likely think it was referring to sluts, farts, etc. as described in Registrant's application, or was just a funny sounding word. Registrant believed at the time of registration that the double entendre, or multiple entendre, of "slart" favored meanings other than "art in Second Life".

16. Registrant denies the allegations of paragraph 16 of the petition for cancellation in as much as the complete statements of the Registrant are not provided and

the quotations contained in paragraph 16 are taken out of context and punctuated by the petitioner with the intent to deceive the Trademark Trial and Appeal Board regarding registrant's statements, which were made legitimately.

Registrant admits that he clearly stated that SLART describes art in Second Life®, accurately stating: "There is no widespread usage of the term SLART to describe art in Second Life beyond my use of it."

17. Registrant denies the allegations of paragraph 17 of the petition for cancellation.

18. Registrant denies the allegations of paragraph 18 of the petition for cancellation.

19. Registrant denies the allegations of paragraph 19 of the petition for cancellation.

20. Registrant denies the allegations of paragraph 20 of the petition for cancellation.

21. Registrant denies the allegations of paragraph 21 of the petition for cancellation.

22. Registrant denies the allegations of paragraph 22 of the petition for cancellation.

23. Registrant denies the allegations of paragraph 23 of the petition for cancellation.

24. Registrant denies the allegations of paragraph 24 of the petition for cancellation.

25. Registrant denies the allegations of paragraph 25 of the petition for cancellation.

26. Registrant denies the allegations of paragraph 26 of the petition for cancellation.

27. Fraud is the only basis petitioner alleges in its petition for cancellation, which is based on unfounded accusations that registrant did not use SLART® in commerce on or before March 22, 2007 for all of the services for which he claimed actual use in commerce in his application or respectively on or before December 21, 2007 for all of the services for which he claimed an intent to use in his trademark application.

Petitioner will not be able to prove that Registrant had not truthfully and with reasonable and legitimate bases made the representations in his application and subsequent Statement of Use filed with the USPTO.

### **AFFIRMATIVE DEFENSES**

The petition for cancellation, although crafted to appear valid, is based on statements taken out of context and references to rights that do not exist.

1. Petitioner has not and will not be damaged by the registration of the trademark SLART® and therefore lacks standing to petition to cancel the registration.

Petitioner assumed the risk of damage to itself. Petitioner has no right to the generic descriptive term SL and any claim of damage to petitioner is of its own doing. Petitioner failed to accurately identify its interest in the generic descriptive term SL prior to its adoption by the general public.

2. Petitioner is barred from seeking cancellation of the registrant's trademark under the doctrines of laches, estoppel, waiver and unclean hands.

3. Petitioner has acquiesced in registrant's adoption, registration and use of the mark that is the subject of the petition for cancellation.

4. Petitioner made a material omission to the TTAB by filing the petition for cancellation and failing to inform the TTAB of ongoing proceedings before the Northern District Court of NY initiated by the registrant to clarify the rights and obligations of the parties regarding the SLART trademark.

Petitioner's persistent refusal to recognize the authority of the USPTO in granting the SLART® mark as evidenced by its refusal to enforce the trademark against acts of infringement in Second Life® prior to filing the petition for cancellation, after repeated requests and reports of damage to the registrant, should prevent this groundless claim from being heard.

WHEREFORE, Registrant prays that the Cancellation be dismissed with prejudice.

Respectfully Submitted,



Date: September 10, 2008

Tamiko R. Franklin  
Bar no. 658453  
Virtual Intellectual Property Organization, Inc.  
276 Washington Street #230  
Boston, Massachusetts  
02108  
[legal@vipo-online.org](mailto:legal@vipo-online.org)  
+385 91 482 8855



Cancellation No. 92049828

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION** was served on counsel for petitioner, this   10   day of September 2008, by sending the same via email and FedEx courier service, to:

Bobby A. Ghajar  
James Cady  
HOWREY LLP  
1950 University Avenue, 4<sup>th</sup> Floor  
East Palo Alto, CA 94303  
[CadyJ@howrey.com](mailto:CadyJ@howrey.com)  
[GhajarB@howrey.com](mailto:GhajarB@howrey.com)  
[IPDocketing@howrey.com](mailto:IPDocketing@howrey.com)



---

Tamiko R. Franklin  
Attorney for the Registrant